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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,445	05/30/2000	E. Barton Manchester	062891.0390	1676

7590 05/06/2005
Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201-2980

EXAMINER

PEYTON, TAMMARA R

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,445

Applicant(s)

MANCHESTER, E. BARTON

Examiner

Tammara R Peyton

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-31 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

The restriction rejection of claims 29-31 is hereby withdrawn based on the amended claims filed 01/04/05.

Claim Rejections - 35 USC § 112

Claims 1, 11, 20, 26, and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added claims language "automatically placing the card in a reset mode in response to powering up of the card" in claims 1, 11, 20, and 26, and the claim language "transitioning into a power up status at a card comprising a processor and a memory accessible to the processor" in claim 29, is not described in the specification. In the specification, pg. 10, line 7, it states "Each line card 16 is placed in the reset state 202 when activated, reset, etc..", specifically the term activated does not convey to one skilled in the art that the card is "powered up" when activated. In the remarks filed 01/04/05, Applicant argues that "Chieng can update boot programming on the PCI device when desired, but Chieng

does not disclose the above-described limitations including automatically placing the card in reset mode and performing particular acts upon being powered-up", pg. 9. One of ordinary skill would readily recognize that when the term activation (pg. 10, line 7 and also pg. 4, lines 18-27) is used in regards to a card does not necessarily mean that programming of the card is performed the first time of activation (powered up) as seems to be the argument of Applicant as to why Chieng does not teach the newly claimed invention, but activation of a card could mean when a particular card is selected for programming. Correction/Explanation is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-13, 17-21 and 26-28 rejected under 35 U.S.C. 103(a) as being unpatentable over *Chieng et al.*, (US 6,035,346).

As per claim 1, 2, 11, 12, 18, 19, and 26-28, *Chieng* teaches a method for automatically placing the card in a hold or wait mode (reset) in response to activation (selection) of a card in a network element comprising one or more switch (adapter) cards, the method comprising:

in response to placing the card in hold or wait mode:

communication a signal indicating a type of the card (obvious);
retrieving an executable file stored remotely (host processor) from the card and
switch (adapter) cards based at least in part on the type of the card,;
downloading the executable file to a memory (515/520, Fig. 5 or 810/815, Fig. 8)
for a processor (510 or 805) on the card without requiring the use of boot code on the
card; and removing the card from the hold or wait state and operating the card using the
executable file. (Abstract, col. 2, lines 47-col. 6, lines 1-20)

Chieng teaches a method of placing the card in a hold or wait mode in response
to selection of a card and determining a type of card and retrieving an executable file
stored on a remote memory (110, Fig.5) and downloading the executable file to the
card's memory (515/520, Fig. 5 or 810/815, Fig. 8) without using boot code on the card
because the card is put into a hold state during the download. *Chieng* does not
expressly teach of the card being a switch card, however, one of ordinary skill would
readily recognize that *Chieng* would have motivate to implement a host of other types of
cards using *Chieng's* system because doing so would add and expand the flexibility of
Chieng without departing from the inventive concept.

As per claim 3, 13, 20, 21, and 29-31, *Chieng* teaches holding/suspending the
processor while downloading the executable file and releasing the processor
subsequent to the download.

As per claims 8-10, and 17, *Chieng* does not expressly teach a dedicated download card, however, one of ordinary skill would readily recognize that *Chieng's* host processor teaches retrieving and downloading the appropriate executable file based on the inserted card. Further, as for the card transmitting a present or reset message to host processor, *Chieng* teaches the processor recognizing an inserted card, therefore it would have been obvious to one of ordinary skill at the time the invention was made that the card would transmit a signal alerting the host processor to its present in the system.

Claims 4-7, 14-16, and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Chieng et al.*, (US 6,035,346) and *Berenbaum et al.*, (US 6,272,144)

As per claims 4-7, 14-16, and 22-25, *Chieng* does not expressly teach a card comprising a field-programmable gate array (FPGA). However, *Berenbaum* teaches a line card comprising a FPGA (*Berenbaum*, 104, Fig. 8) is well known in the art. Therefore, it would have been obvious to one of ordinary skill that it would not be out of the scope of *Chieng's* card to implement a FPGA as described in *Berenbaum*, because doing so would control the transmission protocol of the line card. (*Berenbaum*, col. 7, lines 25-39)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin, can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks
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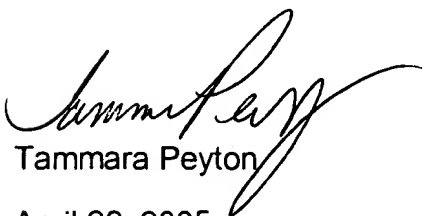
Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

(703) 872-9306

Hand-delivered responses should be brought to:

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Crystal Plaza Two, Lobby Room 1B03, Arlington, VA, 22202Crystal Park II, 2121.



Tammara Peyton

April 29, 2005